REMARKS

Claims 1-13, 15, 16, 18-25, 27-33, 35-41 and 43-45 are pending. Applicant respectfully requests favorable reconsideration and allowance of this application in view of the above amendments and the following remarks.

It is respectfully requested that the examiner update his cut-and-paste from the claims. It is extraordinarily difficult to understand the rejection when it quotes claim language that no longer exists, and completely omits features which are presently recited.

Office Action is Incomplete

In the previous office action dated December 12, 2008, dependent claims 15, 18, 20, 28, 33, 36, 41 and 44 were rejected under 35 USC 103(a) as being obvious over U.S. Patent Pub. No. 2002/0011636 to Grainger ("Grainger") in view of U.S. Patent No. 5,970,490 to Morgenstern ("Morgenstern"). On pages 18 and 19 of a Response thereto filed on April 23, 2009, applicant expressly traversed the rejection of dependent claims 15, 18, 20, 28, 33, 36, 41 and 44 and presented detailed argument with respect to Grainger's deficiencies. The outstanding office action stated on page 2 that "Applicant's arguments with respect to claims 1-13, 15-16, 18-25, 27-33, 35-41 and 43-45 have been considered but are moot in view of the new ground(s) of rejection."

However, the current office action's rejections of claims 15, 18, 20, 28, 33, 36 and 41 <u>are identical to the previous rejection</u> without responding to the clear traversal presented in Applicants' previous Response filed April 23, 2009. This failure to answer the substance of Applicants' arguments renders the office action incomplete as to all matters, to the contrary of 37 C.F.R. § 1.104(b). Further, MPEP § 707.07(f) states that "<u>[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's</u>

argument and *answer the substance of it*" (*Id.*, emphasis added). "*The examiner must address all arguments which have not already been responded to in the statement of the rejection*" (MPEP § 707.07(f), Examiner Note 1).

Failure to specifically respond to applicant's arguments renders the office action arbitrary and capricious, and therefore invalid under the Administrative Procedure Act (5 U.S.C. § 706), a standard to which all Actions by the USPTO must adhere (see *Dickenson v. Zurko*, 527 U.S. 150 (1999)).

Applicant respectfully requests that the Examiner address the substance of Applicants' arguments in the next office action, *including arguments concerning dependent claims*.

Rejection under 35 USC 103(a)

Claims 1-13, 15, 16, 18-25, 27-33, 35-41 and 43-45 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent Pub. No. 2002/0011636 to Grainger ("Grainger") in view of U.S. Patent No. 5,991,751 to Rivette ("Rivette '751"). The office action quotes language from the independent claims dated January 3, 2007, which were changed by the Amendment dated June 26, 2007 and subsequent amendments. Thus, it appears that the examiner has examined independent claims from January 3, 2007. Insofar as the rejection may be applied to the present claims, applicant respectfully traverses the rejection for reasons including the following, which are provided by way of example.

As stated by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) and re-iterated in *KSR*, obviousness requires the examiner to make the following factual inquiries:

(A) Determining the scope and content of the prior art;

(B) Ascertaining <u>the differences between</u> **the claimed invention** <u>and the prior art</u>; and

(C) Resolving the level of ordinary skill in the pertinent art.

Here, the examiner has completely failed to perform step (B), ascertaining the differences between the claimed invention and the prior art. Specifically, the examiner compares claims from January 3, 2007 and ignores changes which occurred in the four subsequent amendments. The following elements are not discussed or even hinted at in the office action; a careful review of Grainger fails to show where they might possibly be discussed:

- "accepting a user's selection of a <u>plurality of attributes to be associated with a</u> ***single pre-determined*** <u>attribute type</u> for the at least one document, the attribute type having parent and child attribute types, <u>the selected attributes being</u> ***predetermined*** and having different parent attributes, <u>attribute types being</u> **predetermined** and ordered in a predetermined tree-structure hierarchy."

- "automatically tagging ... the documents ... with the selected attributes, and <u>with all attributes of all ancestors</u> ***but not descendants or siblings*** <u>according to the hierarchy of the selected attributes</u>"

- "...retrieval of individual documents in the group <u>by searching the **ancestor attributes instead of the selected attributes.**</u>"

There is an egregious failure in the office action to ascertain the differences between the claimed invention and the prior art, which cannot be excused as a minor oversight or clerical error.

Per the claims, there is a "pre-determined tree-structure hierarchy" in which <u>attribute types</u> are ordered, with parent and child attribute types; furthermore the selected <u>attributes</u> are in

a hierarchy and have ancestors. Thus, in an example operation, a pre-determined tree structure can be set up for attribute types, e.g., "company, division, technology type, product;" and a hierarchy can be set up for the predetermined attributes, e.g., an attribute type of "company" can take "ABC Corp." or "XYZ Corp"; the attribute "ABC Corp" can have a child attribute of "Electrical Division" or "Medical Division"; the attribute "Electrical Division" can have a child attribute of "copier technology" or "printer technology" or "facsimile technology. The "copier technology" can have a child attribute of "Model 123" or "Model 123B"; and so on. (See discussion on page 60 of the specification.)

In operation of such a system, for example, the user can cause patents to be tagged as "copier technology," where the attribute type is "Technology Type" and the attribute is "copier technology." Because of both the <u>attribute type</u> tree and the <u>attribute</u> hierarchy, the user can search for patents tagged as having the attribute "Electrical Division" without searching for "copier technology," which will nevertheless locate the patents which the user merely assigned as "copier technology."

The examiner admits that Grainger fails to disclose "a document can be associated with plural attributes for each attribute type" and "the attribute types are ordered in a tree-structure hierarchy," and cites Rivette as remedying the deficiencies of Grainger.

First Difference

The examiner identifies Rivette as disclosing "a document associated with a plurality of attributes for each attribute type" (fig. 12, item 1222). Possibly the examiner is attempting to relate to the recitation "user's selection of a plurality of attributes to be associated with a single predetermined attribute type for the at least one document." Rivette discloses that patent database 1222 includes a record for each patent with the following attributes: AppNo, AppDate,

title, issue data, NumClaims, AsstExaminerLastName, AsstExaminerFirstName,

PrimaryExaminerLastName, PrimaryExaminerFirstName, NumDrawingPages, disclaimer date,

ReissueLevel, ReissueAppNo, ReissueAppDate, ReissuePatentNo, ReissueIssueDate, AppType,

PubLevel, ArtUnit,ExaminplaryClaimNo, NumFigures, NumSpecPages, TermYears,

IntleEdition, calculated expiry date, and user defined field(s). (Col. 57, line 10 to col. 58, line

16.)

AS BEST UNDERSTOOD, the examiner considers Rivette's attribute fields (e.g.,

AppNo., AppDate, etc.) to correspond to the recited attribute types, and the Rivette's stored

contents of the attribute fields to correspond to the recited attributes. However, this fails to

disclose "plurality of attributes to be associated with a *single pre-determined* attribute type",

where documents are tagged "with all attributes of all ancestors *but not descendants or siblings*

according to the hierarchy of the selected attributes." If Rivette's AppNo, AppType, etc. are to

be regarded as the tree-structure hierarchy of attribute types, then none of the references disclose

tagging documents with the "all attributes of all ancestors but not descendants or siblings,"

because tagging a document with, e.g., NUM CLAIMS does not cause the document to be

tagged with, e.g., ISSUE DATE, TITLE, and all the other illustrated "parent" attributes of FIG.

12H.

Accordingly, the combination of elements in the independent claims is respectfully

submitted to be patentable over Grainger and Rivette, alone or in combination with the other

references.

Second Difference

The examiner cites Grainger, paragraph [0016], lines 1-5 as disclosing "later retrieval of

individual documents in the first data storage." Note that the entire segment recites "later

retrieval of individual documents in the group <u>by searching the **ancestor attributes instead of the selected attributes**</u>". The portion cited by the examiner states:

> In another embodiment the method includes storing a plurality electronic documents related to a patent application in a database accessible to a server system, where each of the plurality of electronic documents has one or more attributes associated therewith ..."

Nowhere does this portion of Grainger even imply that the <u>ancestor attributes</u> can be searched, <u>instead of searching for the selected attributes</u> that the user selected for the document. Keep in mind that the claim recites that the documents are tagged "<u>with all attributes of all ancestors *but not descendants or siblings* according to the hierarchy of the selected attributes</u>"; the recited system operates correctly despite a situation that ancestor is not one of the selected attributes.

Moreover, as agreed to in the interview of March 5, 2009, "storing ... respective references ... for later retrieval of individual documents in the group by searching the *ancestor* attributes" is very different from a typical search.

Accordingly, the combination of elements in the independent claims is respectfully submitted to be patentable over Grainger and Rivette, alòne or in combination with the other references.

Hence, Grainger and Rivette `751, alone or in combination, fail to teach or suggest the combination of features recited in independent claims 1, 22, 30 and 38. In addition, Grainger and Rivette `751 clearly fail to show other recited elements as well.

Dependent Claims

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 22, 30 and 38, but also because of additional features they recite in combination.

Furthermore, it is noted that the office action fails to attempt to make a complete *prima facie* case of obviousness for various dependent claims. These are outlined below. Each of these arguments was previously presented but has not been considered in any office action.

Dependent Claims 4, 5

It is noted that the office action has typographical errors in its numbering of dependent claims 4 and 5, as noted for the fifth time. The office action switched the contents of claims 4 and 5. The examiner is respectfully requested to correct this error.

Dependent Claims 15, 25, 33, 41

Claim 15 recites that "the attributes are selected from a plurality of attribute types representative of at least one of: a product and a service." The office action argues that Grainger discloses a plurality of attribute types, and cites Grainger paragraphs [0134] and [0016]. The office action is devoid of any indication where Grainger teaches attribute types representative of product or service. In any event, Grainger fails to teach or suggest attribute types representative of product or service. Accordingly, claim 15 is allowable over the references.

Claims 25, 33, and 41 also include the same recitation as claim 15. The rejections of claims 25, 33 and 41 in the office action merely refer back to the rejection of claim 15. Accordingly, claims 25, 33 and 41 are allowable over the references.

Dependent claim 18

Claim 18 additionally recites "the step of exporting the tree structure hierarchy including the attributes and the attribute types." The office action argues that Grainger paragraph [0016] discloses a plurality of attribute types, and that Grainger paragraph [0134] teaches attribute types associated with document entities. These citations are completely irrelevant and unrelated to the

entirety of claim 18. The office action is devoid of any attempt to argue that Grainger teaches exporting any data structure, let alone a tree structure hierarchy. In any event, Grainger does not teach or suggest exporting the tree structure hierarchy including attributes and attribute types. Therefore, claim 18 is allowable over the references.

Dependent claims 20, 28, 36, 44

Claim 20 depends from dependent claim 19. Claim 19 recites "further comprising utilizing the attributes as criteria for at least one of searching, retrieving, reporting and viewing the at least one document." Claim 20 then recites that "the attributes can be utilized in combination with: (i) at least one of the attribute types, (ii) at least one sub-type of the at least one attribute type, (iii) a content of at least one field in the at least one document; (iv) a type of at least one field in the at least one document; **and** (vi) information derived from the at least one field in the at least one document." The rejection appears to have mistaken the word "and" in claim 20 for the word "or", and has considered only element (i) recited in claim 20: the office action merely states with regard to claim 20 that "Grainger discloses 'an attribute type' (type attribute associated with document Entities, [0134])." Applicant respectfully requests the examiner to identify where Grainger teaches elements (ii) to (vi).

Because the office action fails to even attempt to show where Grainger teaches five of the elements recited in claim 20, applicant respectfully submits that the rejection of claim 20 must be withdrawn.

Claims 28, 36 and 44 include the same recitations as claim 20. The rejections of claims 28, 36 and 44 in the office action merely refer back to the rejection of claim 20. Accordingly, claims 28, 36 and 44 are allowable over the references.
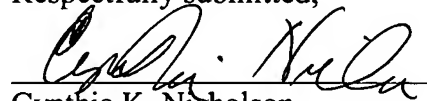
Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicant has provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, applicant submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,

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